REMARKS/ARGUMENTS

Consideration of the above-identified application in view of the following remarks is requested.

Claims 1-8 and 10-21 are pending in the application. Claims 1 and 6 have been amended without prejudice. It is respectfully submitted that no new matter has been added by virtue of this amendment.

A. 35 U.S.C. § 112, second paragraph

Claim 1

In the Office Action the Examiner rejected claim 1 under 35 U.S.C. 112, second paragraph for "failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." In particular, the Examiner noted that with respect to X1 and X2, "the limitation 'when one of X1 or X2 is nitrogen' lacks antecedent basis . . . . "

In response, claim 1 has been amended without prejudice such that with respect to X^1 and X^2, claim 1 now recites that "X^1 and X^2 are either both carbon, X^1 is carbon and X^2 is nitrogen, or X^1 is nitrogen and X^2 is carbon." In view of the amendment to claim 1, the Examiner is respectfully requested to remove this rejection.

Claims 18 and 19

In the Office Action the Examiner also rejected claims 18-19 under 35 U.S.C. 112, second paragraph. With respect to claims 18-19, the Examiner alleged that "the claims are drawn to treating "a disorder caused by an excess of very low density lipoproteins (VLDL) or low density lipoproteins (LDL)", and "[i]t is unclear what diseases this is meant to encompass."

This rejection is traversed. It is respectfully submitted that one or ordinary skill in the art would understand what disorders are caused by an excess of very low density lipoproteins (VLDL) or low density lipoproteins (LDL), particularly in view of the present specification, for

example at page 13, line 6 to page 14, line 5. As such, the Examiner is respectfully requested to remove this rejection.

B. 35 U.S.C. § 112, first paragraph

Claims 1-17

In the Office Action the Examiner rejected claims 1-17 under 35 U.S.C. 112, first paragraph "because the specification, while being enabling for certain compounds it does not reasonably provide enablement for the scope of compound bearing the extensive list of substituents." In particular, the Examiner alleged that "R1-R4 are enabled as written for pyridine and benzene (where X1-X3 is carbon or one or X1-X3 is N), but with respect to certain definitions of X1, X2, and X3, namely where X2 and X3 are N and X1 is carbon and where X1 is N and X3 is N and X2 is C, the claims are not enabled." Further the Examiner alleged that "[w]ith respect to (C=O)-Y-R5 only benzyl or alkyl esters and amides are enabled not the 14 heteroaryl groups claimed."

This rejection is traversed. "The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.* 857 F.2d 778, 785, 8 USQP2D 1217, 1223 (Fed. Cir. 1988). Also, "[n]othing more than objective enablement is required, and therefore, it is irrelevant whether [a] teaching is provided broad terminology or illustrative examples." *In re Wright*, 999 F.2d 1557, 1561, 27 USQP2d 1510, 1513 (Fed. Cir. 1993).

The case law does not require each possible compound encompassed by the claims to be exemplified. *See, e.g., In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 84* (CCPA 1970)("As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, the then enablement requirement of 35 U.S.C. 112 is satisfied."). Thus, Applicants are not required to exemplify every compound which would be encompassed by the claims.

In making the rejection, the Examiner noted the fluoronitrodiazine starting material in the solid phase synthesis technique as depicted in Scheme 1. However, Applicants note that the

compounds are not limited to being prepared by this process in Scheme 1, and the Examiner's attention is further directed to the processes described in pages 7-10 as well as throughout the specification. It is respectfully submitted that in view of the processes described at pages 7-10 and throughout the specification, one of ordinary skill in the art would be to prepare the compounds as claimed without undue experimentation.

In addition, Applicants have provided a number of exemplified compounds (e.g., Table F-1), and pharmacological examples on page 26 of the specification, including IC50 data in Table C1. Therefore, it is respectfully submitted that having been provided with the information set forth in the present specification, one of ordinary skill in the art would without undue experimentation be able to make the compounds covered by the claims. Further, it is respectfully submitted that Applicants have disclosed making and using compounds that bear a reasonable correlation to the entire scope of the claim and one of ordinary skill in the art would understand that the heteroaryl groups of R5 would have the desired activity.

In view of the aforementioned, the Examiner is respectfully requested to remove this rejection with respect to claims 1-17.

Claims 20-21

In the Office Action the Examiner also rejected claims 20-21 under 35 U.S.C. 112, first paragraph for "because the specification, while being enabling for certain compounds to treat hyperlipidemia, obesity, atherosclerosis, or type II diabetes, it does not reasonably provide enablement for the protracted list of compounds bearing the protracted list of substituents."

This rejection is traversed. As noted above with respect to claims 1-17 Applicant has provided numerous examples, including pharmacological examples. It is respectfully submitted in view of the specification and in particular the examples provided in the specification, one of ordinary skill in the art would understand that the compounds as claimed would be useful for treating the disorders recited in claims 20-21, and the Examiner is respectfully requested to remove this rejection.

C. Provisional Obviousness-type Double Patenting

1. Claims 1-7, 12-17 over 11/558,655

In the Office Action, the Examiner provisionally rejected claims 1-7, 12-17 "on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-7 of copending Application No. 11/558,655."

2. Claims 1-8, 10-17 over 11/854,632

In the Office Action, the Examiner provisionally rejected claims 1-7, 10-17 "on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 11/854,632

3. Claims 1-8, 10-21 over 11/551,288

In the Office Action, the Examiner provisionally rejected claims 1-8, 10-21 "on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-24, 26-31 of copending Application No. 11/551,288

4. Claims 1-8, 10-21 over 11/928,942

In the Office Action, the Examiner provisionally rejected claims 1-8, 10-21 "on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16, 18 of copending Application No. 11/928,942.

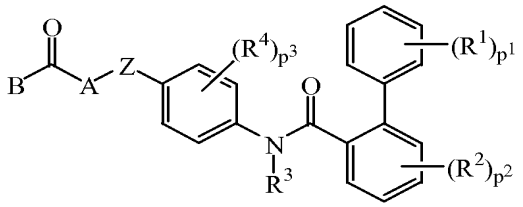
In response, as these nonstatutory obviousness-type double patenting rejections are provisional, Applicants will address these rejections upon indication that the claims are otherwise allowable.

D. Obviousness-type Double Patenting

Claims 1-7, 12-17 over 7,304,167

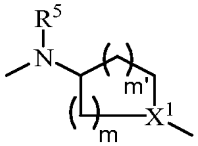
In the Office Action, the Examiner rejected claims 1-8, 10-21 "on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-7 U.S. patent 7,304,167.

This rejection is traversed. Applicants note that claim 1 of U.S. Patent 7,304,167 is directed to compound of formula (I):



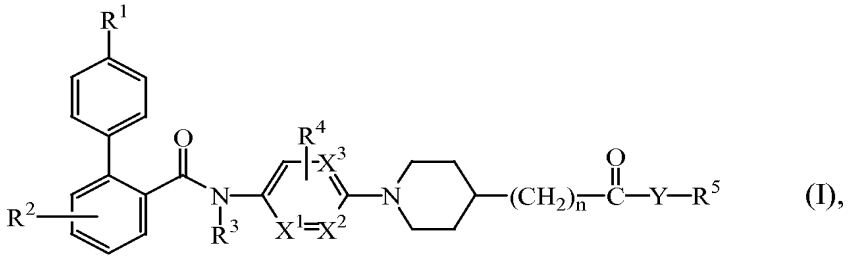
(I),

wherein the A group represents a bond, or C_{1-6}alkanediyl optionally substituted with one or two groups selected from the group consisting of aryl, heteroaryl and C_{3-10}cycloalkyl; and the Z group is a bivalent radical of the formula



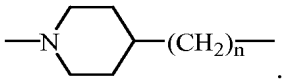
(a-2)

In contrast claim 1 of the present application recites a compound of Formula (I):



(I),

and it is respectfully submitted that the group corresponding to the structural –A—Z— group of Formula (I) of U.S. Patent 7,304,167 would be as follows:



In view of the above, it is respectfully submitted that the claims of U.S. Patent 7,304,167 fail to teach or suggest the compounds as recited in the present application at least for the differences with respect to the corresponding structural –A—Z— group.

Thus, the Examiner is respectfully requested to remove this obviousness-type double patenting rejection.

Please charge any fees, which may be required for this submission to Johnson & Johnson Deposit Account 10-0750/JAB1742USNP/DK.

Early favorable action on the merits is respectfully requested.

Respectfully submitted,

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